

claim. As Benayoun does not teach a step of performing echo cancellation on the circuit-based signal, the Examiner should withdraw the 102(e) rejection of claim 13 and pass the claim to allowance.

Similarly, the rejection of dependent claim 14 is traversed. The rejection should be withdrawn and the claim passed to allowance.

35 U.S.C. §103 rejections:

The Examiner has rejected claims 1-12 and 15-18 under 35 U.S.C. 103(a) as being unpatentable over Benayoun et al, U.S. Patent 5,959,992. Applicant respectfully disagrees and traverses the rejections.

Regarding claim 1, the Examiner has asserted that it would have been obvious to one of ordinary skill to combine the echo cancellation function in the echo cancellation brick 1440 into the interface brick 1435 if no unexpected results can be seen from combining the two bricks (pg. 6 of the Office Action). Applicant respectfully disagrees.

The Examiner has not provided a suggestion or motivation to alter the invention of Benayoun to make the Applicant's claimed invention. The test for obviousness is whether combined teachings render the claimed subject matter obvious. *In re Wood*, 599 F.2d 1032 (C.C.P.A., 1979). Benayoun does not teach that multiple functions may be incorporated into one brick. On the contrary, the reference teaches that certain functions, such as voice capabilities and data compression, are dedicated to specific bricks (col. 21, lines 27-29, 46-48). It further emphasizes that one of the invention's advantages over prior art is its modularity (col. 5, line 58). Therefore, Benayoun teaches *away* from the combination of functions into single bricks.

When the necessary suggestion or motivation has not been provided, there is a presumption that the obviousness rejection was based on hindsight. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998).

Furthermore, “[I]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that ‘one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’” *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

As the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. §103 rejection of claim 1 should be withdrawn and the claim passed to allowance.

Regarding claim 2, the Examiner has asserted that it would have been obvious to one of ordinary skill to combine the echo cancellation function in the echo cancellation brick 1440 into the interface brick 1435 if no unexpected results can be seen from combining the two bricks (pg. 6 of the Office Action). Applicant respectfully disagrees. For the same reasons as for claim 1, the 35 U.S.C. §103 rejection of claim 2 should be withdrawn and the claim passed to allowance.

Regarding claim 3, the claim comprises at least a packet switch fabric capable of transferring packet-based signals among the circuit network server and a second circuit network server. The Examiner has cited the ISDN gateway brick 1430 as the second circuit network server, referencing Figure 14 and col. 20, lines 58-65. Applicant respectfully disagrees. In no way can this element be construed as a second circuit network server. The patent states that the “OSI level 2 and 3 layers...is (sic) handled by the ISDN gateway brick 1430 which, therefore, will provide the necessary functions and procedures to establish an internal ISDN or QSIG call or still, for establishing a call for ISDN external links.” (col. 20, lines 58-62) Therefore, ISDN gateway brick 1430 establishes calls within the ATM structure, but does not interact with a network in any way so as to be construed as a second circuit network server. As Benayoun does not teach a packet switch fabric capable of transferring packet-based signals among the circuit network

server and a second circuit network server, the Examiner should withdraw the 103(a) rejection of claim 3 and pass the claim to allowance.

Regarding claim 15, the Examiner has asserted that it would have been obvious to one of ordinary skill to combine the voice compression function in the voice compression brick 1460 into the interface brick 1435 if no unexpected results can be seen from combining the two bricks (pg. 10 of the Office Action). Applicant respectfully disagrees. For the same reasons as for claim 1, the 35 U.S.C. §103 rejection of claim 15 should be withdrawn and the claim passed to allowance.

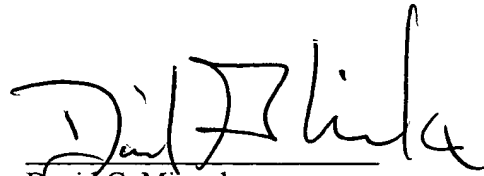
Likewise, the rejections for dependent claims 4-12, 16-18 should be withdrawn and the claims passed to allowance.

Applicant's discussion of particular positions of the Examiner does not constitute a concession with respect to any positions that are not expressly contested by the Applicant. Applicant's emphasis of particular reasons why the claims are patentable does not imply that there are not other sufficient reasons why the claims are patentable.

CONCLUSION

In view of the foregoing remarks and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. If the examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David G. Miranda", written over a horizontal line.

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